



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,511	12/14/2001	Arnold J. Reuser	24414-Y	3913

20529 7590 09/11/2003

NATH & ASSOCIATES
1030 15th STREET
6TH FLOOR
WASHINGTON, DC 20005

EXAMINER

BERTOGLIO, VALARIE E

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 09/11/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,511

Applicant(s)

REUSER ET AL.

Examiner

Valarie Bertoglio

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 and 17-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-10, 15 and 16 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that it would not require undue burden to examine Groups I-IV in combination and that a search of any one group would require searching prior art areas appropriate to the other invention groups. Applicants argue that a search of any one group would reveal art relevant to other invention. This is not found persuasive because, for example, a search for the animal of invention I would not necessarily reveal methods of purifying acid alpha-glucosidase or a pharmaceutical comprising acid alpha-glucosidase. Furthermore, each group is drawn to patentably distinct inventions. Group I is drawn to a transgenic animal and milk derived from the animal. Group II is drawn to incorporating milk into a food product. Group III is drawn to purification of a protein. Group IV is drawn to a pharmaceutical.

Applicants point out that claims 54-61 were not included in the restriction. These claims were inadvertently omitted and are included with Group IV such that Group IV includes claims 18-67, drawn to a pharmaceutical comprising acid alpha-glucosidase.

The requirement is still deemed proper and is therefore made FINAL.

Priority

1) Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior

application is required. This application claims benefit of U.S. Patent Application Serial No. 08/700,760 filed 07/29/1996 which was granted 09/12/2000, prior to the filing date of the current application of 12/14/2001.

2) This application repeats a substantial portion of prior Application No. 09/770,496, filed 01/29/2001, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or

Art Unit: 1632

sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

3) The priority paragraph in the specification is unclear. The statement reads that provisional application 60/111,291 was published as WO 00/34451. US Provisional applications are not published as WO documents. The basis of priority to WO 00/34451 is unclear and is not clarified by or stated in the Oath. Clarification is necessary.

4) Because the instant application appears to be a continuation of US Patent Application 09/770496, filed 01/29/2001, for the purposes of current examination, a priority date of 01/29/2001 is assumed. Priority is not granted to U.S. Provisional Applications 60/001796, filed 08/02/1995 and 60/111,291, filed 12/07/1998, because U.S. Provisional Applications are considered abandoned 12 months following the filing date and thus expired prior to the filing date of US Patent Application 09/770496 (refer to 35 U.S.C. 119 (e) (1)).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-10, 15 and 16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10, 15 and 16 of prior U.S. Patent No. 6,118,045. This is a double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

Art Unit: 1632

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Reuser et al. (USPN 6,118,045)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Reuser taught transgenic mice comprising a transgene comprising the α -S1-casein promoter and enhancer operably linked to the human acid α -glucosidase gene and a secretory DNA segment from the acid α -glucosidase gene (col. 6, line 64-col. 7, line 17; col. 12, line 50-col. 13, line 37) wherein the transgene is expressed in an adult female or a female descendent thereof, such that acid α -glucosidase is processed and secreted by the mammary secretory cells into the milk of the animal (column 15, lines 52-59) as encompassed by claims 1,3 and 5-9. The milk was isolated from the transgenic mice and the acid α -glucosidase was recovered and tested for catalytic activity (column 15, lines 51-67) as encompassed by claim 10 and 15. The estimated specific activity of the acid α -glucosidase in the milk was as much as 11.3mg/L when an acid α -glucosidase cDNA was used in the transgene and as much as 3.3g/L when a genomic acid α -glucosidase DNA was used in the transgene (col. 16, lines 1-4) as encompassed by claims 2 and 16. Accordingly, Reuser anticipates the claimed invention.

Conclusion

Art Unit: 1632

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is 703-305-5469. The examiner can normally be reached on Mon-Weds 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on 703-305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

PETER PARAS
PATENT EXAMINER



Valarie Bertoglio
Examiner
Art Unit 1632
